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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,566	10/11/2001	Tassie Collins	018781-008600US	7494

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EXAMINER
STOCKTON, LAURA

ART UNIT	PAPER NUMBER
1626	12

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on March 20, 2003

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 85-98 is/are pending in the application.
Of the above, claim(s) 89, 94, 97 and 98 is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 85-88, 90-93, 95 and 96 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/975,566

* U.S. GPO: 1996-404-496/40517

DETAILED ACTION

Claims 85-98 are pending in the application.

Election/Restrictions

Applicants' election with traverse of Group II (products), and the species of Example 12 on page 41, in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the search of the remaining claims would not provide an undue burden on the Office.

Applicants' arguments have been considered but have not been found persuasive. Separate search considerations are involved for each of the inventions and therefore, it would impose an undue burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

The generic concept that has been examined, inclusive of the elected species of Example 12 on page 41, is as follows:

X is S;

Y is N(R^5)

Z is N

W is an unsubstituted or substituted naphthyl ; and

R^1, R^2 and R^5 are hydrogen or a fully saturated unsubstituted (C_1-C_8)alkyl.

Claims readable on the generic concept are claims 85-88, 90-93, 95 and 96.

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by the above identified generic concept and claims 89, 94, 97 and 98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to

nonelected inventions. Applicants timely traversed the restriction (election) requirement in Paper No. 10.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 85-88, 90-93, 95 and 96 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-14, 17-19, 22-26, 31-35, 38-40 and 43 of copending Application No. 10/155,605 (see corresponding Patent Application Publication – US 2003/0018022). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed invention and the claims of the patent differ only by generic description of the products. See claim 1 of the patent application publication and especially the first compound listed in claim 31 of the patent application publication.

One skilled in the art would thus be motivated to prepare products embraced by 10/155,605 to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful for modulating CCR4 chemokine receptor activity. Therefore,

the instant claimed invention would have been suggested to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 85-88, 92, 93 and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by:

a) Gregory {U.S. Pat. 2,863,874} – see Example VIII in column 7;

b) Dexter et. al. {U.S. Pat. 3,467,666} – see Example 20 in column 10;

c) Fernandes et al. {CA 48:4513g, April 25, 1954} – see the compounds of Beilstein Record (BRN) 226385 and 214151;

d) Das et al. {CA 49:11626c, September 10, 1955} – see, for example, the compounds of Beilstein Records (BRN) 4929712, 3875047, etc.

e) Mahapatra et al. {CA 50:962h, January 25, 1956} - see, for example, the compounds of Beilstein Records (BRN) 3880087, 3880085, 3847239, etc.

f) Tripathy et al. {CA 80:27161, 1974} – see the compounds of CA Registry Numbers 1957-01-3 and 51039-86-2; and

g) Nayak et al. {CA 114:23843, 1991} – see the compounds of CA Registry Numbers 75320-73-9 and 75320-74-0.

Each of the above prior art references discloses compounds embraced by the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 85-88, 90, 92, 93 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregory {U.S. Pat. 2,863,874} and Dexter et. al. {U.S. Pat. 3,467,666}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim thiazole products. Gregory (columns 1 and 3-5; or Example VIII in column 7) and Dexter et al. (columns 1-3; or Example 20 in column 10) each teach thiazole products that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed products.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the products of the prior art and the products instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., a muscle relaxant).

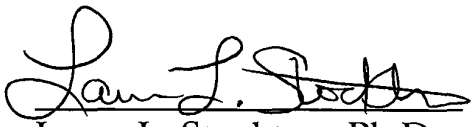
One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as, for example, a muscle relaxant. Therefore, the instant claimed invention would have been suggested to one skilled in the art.

The elected species of Example 12 is not allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.



Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

April 2, 2003